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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,471	04/06/1999	PER WILLARS	2380-122	5036
23117 7590 11/04/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
TRAN, CONGVAN				
ART UNIT		PAPER NUMBER		
2617				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/286,471

**Applicant(s)**

WILLARS ET AL.

**Examiner**

CongVan Tran

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-33, 35-47, 49-62, 64-70 and 72-74 is/are rejected.
- 7) ☒ Claim(s) 34, 48, 63 and 71 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Sept. 02, 2009 has been entered.

### ***Response to Arguments***

2. Applicant(s) should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.
3. Claims 1-26 have been canceled.
4. Claim 41 has been amended.
5. Claims 72-74 have been added.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 28-31, 35-45, 49-60, and 64-70 are rejected under 35 U.S.C. 102(e) as being anticipated by Salkini et al. (6,912,230).

Regarding claims 27, Salkini discloses a radio access network having a first communication protocol, said radio access network defining first cells at least some of which neighbor foreign cell employing a foreign protocol different for said first communication protocol, said foreign protocol associated with a foreign communication system (see fig.9, radio access network 200, first communication protocol 240/241-GSM protocols, foreign protocol different 242/249-TDMA, col.2, lines 44-50), the radio access network comprising: a radio access network node structure for communicating with a multi-mode mobile radio in said first cells (see fig.9, fig.28, radio access network node 200, first cells /480/105/481, multi-mode mobile radio 112, col.26, lines 29-col.27, line 13); and a data mechanism for exchanging handover information through said network node structure with said multi-mode radio as said multi-mode radio is to be handed-over to at least one of said foreign cells, said data mechanism comprising a container structure comprising content expressed in the foreign communications protocol so that the node structure can serve as a conduit for the container and need not understand the content of the container structure (see fig.9, fig.28, element 200, col.26, lines 29-40, col.26, lines 56--col.27, line 13, fig.10, HOP 416, col.27, line 14-col.29, line 20).

Regarding claims 28-31, 35-40, 42-45, 49-55, 57-60, 64-70, Salkini further discloses, wherein the content of the container structure comprises communication parameters for the foreign communication system (communication parameters such as

strength measurement are performed by the aircore platform 200, (see fig.28, col.26, lines 66-col.27, line 5 fig.2, multi protocols MSC 210, AC 213).

Regarding claims 41, 56, Salkini discloses a multi-protocol wireless communication apparatus and method comprising:

a radio access network having an associated first communication protocol for communicating to a multi-mode mobile radio in first cells serviced by said radio access network according to said first communication protocol (see fig.9, radio access network 200, first communication protocol 240/241-GSM protocols, col.2, lines 44-50);

a second network having an associated foreign communication protocol for communicating to the multi-mode mobile radio in at least foreign cells neighboring said first cells and serviced by said second network according to said foreign communication protocol, said radio network and said second network being in handoff communication with each other to handoff said mobile radio when said mobile radio commutes from one of said first cells to one of said foreign cells (see fig.9, foreign protocol different 242/249-TDMA, col.2, lines 44-50); said handoff communication being in accordance with a data mechanism, said data mechanism comprising a container structure comprising content expressed in the foreign communications protocol so that the node structure can serve as a conduit for the container and need not understand the content of the container structure (see fig.9, fig.28, element 200, col.26, lines 29-40, col.26, lines 56--col.27, line 13, fig.10, HOP 416, col.27, line 14-col.29, line 20).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 32-33, 46-47, 61-62 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salkini et al. (6,912,230) in view of Le (6,556,820).

Regarding claims 32, 46, and 61, Salkini discloses all the subject matters described in rejected claims 1, 41 and 56, except for the radio access network is a Universal Mobile Telephone System (UMTS) radio access network and the foreign communication system is one of a Group Special Mobile (GSM). However, Le discloses mobility management for terminals with multiple subscriptions comprising the radio access network is a Universal Mobile Telephone System (UMTS) radio access network and the foreign communication system is one of a Group Special Mobile (GSM) (see fig.9, UMTS 910, GSM 920, col.10, line 50-col.11, line 12). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Le's invention in Salkini to provide broadband services in telecommunication system for improving the global roaming and personalized features and embracing the WCDMA and HSPA technologies.

Regarding claims 33, 47, 62, and 72-74 Le further discloses the radio access network is a third generation and the foreign communication system is second

generation system (see fig.8, third generation 812, second generation 814, col.10, lines 17-49).

***Allowable Subject Matter***

10. Claims 34, 48, 63 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. SEE MPEP 2141.02 [R-5] VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201,73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CongVan Tran whose telephone number is 571-272-7871. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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/CongVan Tran/  
Primary Examiner, Art Unit 2617